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~~No. 1797~~

70-253

In the

Supreme Court of the United States

OCTOBER TERM, 1970

DEERE & COMPANY,

Petitioner,

vs.

HESSTON CORPORATION, HESSTON OF TEXAS, INCORPORATED, and JOE ED CRAWFORD, d/b/a CRAWFORD EQUIPMENT COMPANY,

Respondents.

PETITIONER'S REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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The Scheffer Press, Inc.—ANdover 3-6850

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The crux of the disagreement between petitioner and respondents — and between the majority and minority judges on the panel of the Court of Appeals which heard this case below — is succinctly expressed in the following statement made by respondents in their brief:

> "It matters not an iota whether the use of a simple, ordinary bleed door helps to produce a new, better or different result when used with the blower of an old jet pump as compared with the results of its use with the commonplace suction blower" (Respondents' brief, p. 11).

That statement is in direct and irreconcilable conflict with this Court's pronouncements regarding the significance to be accorded the achievement of a new and unexpected result — or synergistic effect — in cases where the patent in suit covers a combination of individually old elements (*Great A. & P. Tea Company* v. *Supermarket Equipment Corp.* (1950), 340 U.S. 147, 152; *Graham* v. *John Deere Co.* (1966), 383 U.S. 1; *United States* v. *Adams* (1966), 383 U.S. 39; *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co.* (1969), 396 U.S. 57, 61).

Even so, respondents have thus far been successful in "selling" both the District Court and the majority judges of the Court of Appeals on the proposition that any machine which could have been produced by a combination of individually old elements would have been obvious *as a matter of law,* and hence unpatentable, regardless of the result achieved. As Judge Bell states it in the majority opinion of the Court of Appeals:

> ". . . it appears that the jet principle was old in a similar field of endeavor as was the air regulating means . . . The combination of these known elements produced a useful function but the district court did not err in concluding *as a matter of law* on the fact presented that the combination would have been obvious to those skilled in the art . . .
>
> "It is a peculiarity of patent law that it avails Deere nothing to point out that the combination was not obvious to defendant's engineers who gave up and copied Deere's machine" (Petition, 6a; emphasis added).*

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* Judge Bell's statement makes it apparent that the majority of the Court of Appeals held the combination disclosed and claimed in the Deere patent would have been obvious as a matter of law, even though they recognized that it had not been obvious *as a matter of fact* to the re-

Petitioner, of course, has freely conceded that "the device covered by the claims of the patent in suit in this case can be produced by combining the jet pump shown in the Harazin prior art patent and the air regulating means employed in the Herz patent" (Petition, p. 21).

But that fact does *not*, under the controlling decisions of this Court, make the combination of the Harazin jet pump and Herz air regulating means obvious as a matter of law — certainly not where the testimony of both petitioner's and respondents' expert witnesses established that their combination achieved a true synergistic result, exceeding the sum of the conventional functions of the jet pump and air regulating means taken singly.

That synergistic result consisted in obtaining, for the first time anywhere, effective green-boll separation *without* sacrificing ripe-boll delivery capacity. Only by the invention disclosed and claimed in the Deere patent was it possible to avoid the *compromise* (between good separation, on the one hand, and efficient delivery capacity, on the other) that was inherent in all prior-art air elevators. (For a lucid statement as to what that compromise was, how it curtailed the usefulness of the prior-art machines, and how it was eliminated by the invention of the Deere patent, see the testimony of Russell Sutherland quoted at pages 5-8 of the petition.)

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* (Continued)
spondent Hesston's own engineers, or to other workers skilled in the art who had long been struggling with the problem first solved by the patented air elevator. The last sentence of the quoted excerpt from the majority opinion also refutes conclusively the assertion, at page 11 of respondents' brief, that "Anyone skilled in the art of air separation would readily recognize the obviousness of the same association of the air bleed-in door of Herz with a different type of conventional blower".

The novel, no-compromise performance of the patented air elevator stemmed, moreover, from *cooperative action* of the elements which Deere's patentee, for the first time, brought together. The jet pump alone would not do the job without the air regulating means, for if the suction were regulated in the conventional way (by adjustment of the fan speed) the separating air stream and the delivery air stream would be interdependent, just as in the prior art (Joint Appendix, pp. 332-334 and 338-340). Similarly, the result obtained with the patented air elevator could not be had without the jet pump, for the prior-art compromise would be encountered when the air regulating means were used with a conventional suction fan (Joint Appendix, pp. 110-113).

The air elevator disclosed and claimed in the Deere patent is, in short, not a mere aggregation of old elements (each of which performs only its old prior art function, uninfluenced by and indifferent to the action of the other element) but a true combination which achieves a result that is *more* than the sum of its "parts".

Such a combination is patentable, when measured against the standard of invention prescribed by the controlling decisions of this Court and applied in many cases by other panels of the Court of Appeals for the Fifth Circuit.

Conclusion

To judge invention by the standard of patentability employed by the majority judges of the Court of Appeals in this case is to strip it of all intellectual content; it is like saying that Beethoven or Shakespeare gave the world nothing new, since the notes and words they used were all old, per se.

That point has been made many times, but never better than by Judge Learned Hand in *H. C. White Co.* v. *Morton E. Converse & Son Co.* (2 Cir., 1927), 20 F.2d 311, 312-313, where Judge Hand said:

> ". . . Again and again, ad nauseam, courts have been fond of saying that it is the obvious when discovered and put to use that most often proves invention . . . While the statute grants monopolies only for new structures, and not for new uses, invention is not to be gauged by the necessary physical changes, so long as there are some, but by the *directing conception* which alone can beget them" (emphasis added).

The undisputed facts in this case mark the patent in suit as a valid grant of protection for a real invention, and the decision of the majority judges of the Court of Appeals reflects both (1) a misapprehension of the applicable standard of patentability prescribed by the controlling decisions of this Court and (2) the existence of an internal conflict between different panels of the Court of Appeals for the Fifth Circuit which should be resolved, once and for all, by this Court.

The petition for certiorari in this case should be granted and the decision of the Court of Appeals reversed.

Respectfully submitted,

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CERTIORARI DENIED N.C.R.